

REMARKSStatus of the Claims

Claims 17-32 are pending in this application. Claim 16 has been canceled. Claims 17, 18, 22 and 27 have been amended to change dependency. Claims 29-32 have been added. Support for new claims 29 and 30 is found at page 10, lines 27 to page 11, line 10. Support for new claims 31 and 32 is found in Example 18, page 37. No new matter has been added by the above claim amendments.

Rejection under 35 USC 102(b)

The Examiner rejects claims 16 and 18 as anticipated by Kigawa USP 5,798,434 (Kigawa '434). Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants submit that the instant invention is directed to a skin cosmetic or external skin agent comprising a dimerdiol ester of a monocarboxylic acid having 4 to 34 carbon atoms and/or a dimerdiol ester of a dicarboxylic acid.

On the other hand, Kigawa '434 is directed to a polymer for plastic lenses and not directed to a skin cosmetic or external skin agent. Kigawa '434 does not contain the properties required for a skin cosmetic or external skin agent. For example, sensorial properties are not present in the polymer of Kigawa '434 and this property is needed in cosmetics for application to the skin. As such, the present invention is patentable over Kigawa '434, as the

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instant invention is directed to a skin cosmetic or external skin agent and Kigawa is directed to a polymer for plastic lenses. As such, the rejection should be withdrawn.

Rejections maintained under 35 USC 103

The Examiner rejects claims 16-28 as obvious over Ansmann et al. (USP 5,795,978) in view of Harmann et al. (USP 5,739,190) or, Akrongold et al. (USP 3,846,550) and further in view of Clum et al. (USP 5,652,263) and Bernhardt et al. (USP 4,788,054). Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants submit that the present invention is directed to a skin cosmetic or external skin agent comprising a dimerdiol ester of a monocarboxylic acid having 4 to 34 carbon atoms and/or a dimerdiol ester of a dicarboxylic acid. The specific dimerdiol ester of the present invention is a combination of a specific polyhydric alcohol and a specific fatty acid. Due to the specific dimerdiol ester, the present invention exhibits superior properties over cosmetics or external skin agents not containing the specific dimerdiol ester of the present invention. For example, the present invention has superior alkali hydrolysis resistance, stability, safety and superior feelings of use.

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Ansmann discloses esters of fatty acids with polyhydric alcohols, such as dimerdiol along with a laundry list of other

esters of fatty acids. However, Ansmann does not disclose or suggest using the dimerdiol in a cosmetic as opposed to the other fatty acids disclosed.

Pursuant to In re Baird, 29 USPQ2d 1550 (Fed. Cir. 1994), the disclosure of a laundry list of esters of fatty acids also including the claimed dimerdiol does not per se render the claim obvious. Ansmann discloses under the heading "Oils" at column 4 lists several generic esters of fatty acids, included in the list are dimer diols and trimer diols. A complete reading of Ansmann does not motivate one to use a dimer diol in a cosmetic. In fact, in the examples of Ansmann triglycerides based on C6-C10 fatty acids are used.

Applicants submit that the disclosure of Ansmann teaches away from the claimed invention. Please see comparative example 3 data in the specification where triglycerides are used instead of the claimed dimerdiol. The dimerdiol of the present invention has superior properties over the triglyceride taught in Ansmann. As such, Applicants submit that Ansmann does not motivate one of ordinary skill in the art to pick the dimerdiol from the laundry list for use in a skin cosmetic or external skin agent.

Combining Ansmann with Hartmann or Akrongold still does not lead one of ordinary skill in the art to arrive at the present invention. Hartmann discloses also a laundry list of alcohols, including the dimerdiol of the present invention. However, there

is no teaching to use the specific dimerdiol in a cosmetic as with the present invention.

Again, relying on In re Baird, supra, a claim is not per se obvious when a component of the present invention is disclosed in a genus and there is no motivation to pick out the specific species from amongst the many members of the genus. Moreover, the specific fatty acids to be combined with the dimerdiols must also be selected from the list to arrive at the present invention.

The aliphatic dicarboxylic acid esters in Hartmann disclosed at column 5, lines 29-33 are used as a hydrophobic organic dispersion medium (i.e. oily phase) for the polymerization of the vinyl amide compounds. Mono-, di-, and polyglycerol fatty acid esters at column 7, lines 3-4 are used in an emulsifier for the polymerization of the vinyl amide compounds. This has no relation to cosmetics. The final products are used as retention and flocculating agents.

Furthermore, the HLB values of 2 to 10, preferably from 3 to 7 disclosed in Hartmann at column 7, lines 2-3 indicate that the component (b) is hydrophilic and totally different from the dimerdiol esters of the present invention, which are hydrophobic. Clearly, the teachings of Hartmann are in conflict with the teachings of Ansmann. As such, one of ordinary skill in the art would not be motivated to combine teachings to arrive at the present invention.

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Likewise in Akrongold, esters of fatty acids are disclosed in column 1, lines 57-61. However, the esters of Akrongold are used as oils and not as emulsions in combination with urea to produce a powder product. In contrast, the esters in Ansmann are used as oils for emulsion with water to produce an O/W emulsion. This contrast is a prime example of why these references may not be combined. Please also note a further difference in the teaching of Akrongold and Ansmann. At column 4, lines 3-5 Ansmann discloses that the product may be produced with low wax concentrations, which results in a significant improvement in the sensorial properties of the product. On the other hand, Akrongold discloses at column 1, lines 24-37 the use of oils to improve appearance properties by changing a rough discontinuous powder film with an artificial appearance to continuous film having a natural appearance. The improved sensorial properties in Ansmann are caused by a highly viscous cream, which is produced by a low wax concentration. Meaning, the improved properties are not caused by the effects of oils.

Upon review of the entire reference and all the contrary teachings, it is clear that the primary and secondary references are in conflict. As such, one of ordinary skill in the art would not be motivated to combine Ansmann with Akrongold.

For the foregoing reasons, Applicants submit that the present invention is not obvious over Ansmann in view of Akrongold or

Hartmann as one of ordinary skill in the art would not be motivated to combine the references due to the abundance of contrary teachings within the references. In addition, the tertiary references, Clum and Bernhardt do not add any teaching which overcomes the conflicts within the primary and secondary references to motive one to combine the three references to arrive at the present invention. As such, the rejection should be withdrawn.

Conclusion

As Applicants have addressed and overcome all rejections in the Office Action, Applicants respectfully request that the rejections be withdrawn and that the claims be allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kecia Reynolds (Reg. No. 47,021) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

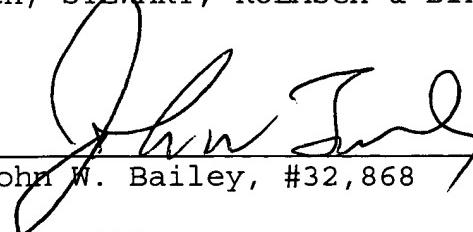
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version with Markings to Show Changes Made

(Rev. 02/20/02)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

17. (Amended) The cosmetic or an external agent according to claim 29 [16], wherein the amount of the dimerdiol ester is 0.1-50 % by weight.

18. (Amended) The cosmetic or an external agent according to claim 29 [16], wherein the dimerdiol ester is of a monocarboxylic acid having 4 to 34 carbon atoms.

22. (Amended) The cosmetic or an external agent according to claim 29 [16], wherein the dimerdiol ester is of a dicarboxylic acid.

27. (Amended) The cosmetic or an external agent according to claim 29 [16], which further comprises an antioxidant.

Claims 29-32 are added.